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**APR 11 2005**

**OFFICE OF PETITIONS**

In re Application of :  
Semba et al. : DECISION ON APPLICATION  
Application No. 10/870,821 : for  
Filed: June 1, 2001 : PATENT TERM ADJUSTMENT  
Attorney Docket No. 04853.0073:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT-PRE-GRANT," filed November 12, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from five (5) days to ninety-three (93) days.

The application for patent term adjustment is **DISMISSED**.

On August 30, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 5 days. On November 12, 2004, applicants timely submitted the instant application for patent term adjustment<sup>1</sup>. Applicants contend that the reduction of 88 days associated with their filing of an Information Disclosure Statement (IDS) on December 2, 2003 is incorrect. Applicants assert that the IDS included a § 1.704(d) statement.

<sup>1</sup> PALM records show that the Issue Fee was received on November 15, 2004.

Applicants state that the above-identified application is not subject to a terminal disclaimer.

Pursuant to 37 CFR § 1.704(c)(8), the submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, is a failure to engage in reasonable efforts to conclude prosecution. It is undisputed that after filing a response on September 5, 2003, on December 2, 2003, applicants filed an IDS. The record does not support a conclusion that the IDS was expressly requested by the examiner.

37 CFR § 1.704(d) provides that:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

A review of the IDS filed December 2, 2003, reveals that it did not include a § 1.704(d) statement<sup>1</sup>. Specifically, the IDS was accompanied by a statement that:

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<sup>1</sup> Applicants are reminded that § 1.704(d) was revised, effective May 24, 2004, as follows:

A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

this Information Disclosure Statement was first cited in a communication from the European Patent Office in a counterpart foreign application, and this Information Disclosure Statement is being filed within three months of the mailing date of that communication

(emphasis added).

Applicants are incorrect in their assertion that the IDS complied with § 1.704(d) by including a statement that "the communication was not received by any individual designated in 1.56(c) more than thirty days prior to the filing of the IDS." The IDS of record does not include such a statement.

Moreover, applicants state that the IDS filed on December 2, 2003, was filed within 30 days of the European Search Report dated November 6, 2003, a copy of which was included with the IDS. However, presenting of such papers is not tantamount to making a statement that the communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. Nor has a proper party made such a statement on request for reconsideration of patent term adjustment.

Accordingly, it is concluded that a period of reduction of 88 days pursuant to § 1.704(c)(8) was properly entered for the filing of the IDS on December 2, 2003.

In view thereof, the determination of patent term adjustment at the time of the mailing of the notice of allowance is 5 days.

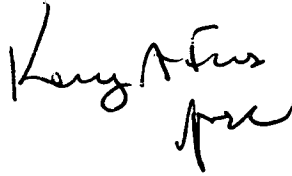
The \$200.00 fee set forth in 37 CFR 1.18(e) has been charged to Deposit Account No. 06-0916, as authorized. No additional fees are required.

The application is being forwarded to the Office of Patent Publication for issuance of the patent.

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This revision requires that the statement include the language "each item of information contained in the information disclosure statement was first cited ..." for the exception to apply. See 69 FR 21704, Apr. 22, 2004.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

A handwritten signature in black ink, appearing to read 'Karin Ferriter', with a stylized flourish below it.

Karin Ferriter  
Senior Legal Advisor  
Office of Patent Legal Administration  
Office of Deputy Commissioner  
for Patent Examination Policy